



PATENT
Customer No. 22,852
Attorney Docket No. 06148.0026-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Richard D. BUCHOLZ et al.) Group Art Unit: 3737
Serial No.: 09/832,848) Examiner: E. Mantis Mercader
Filed: April 12, 2001)
For: SURGICAL NAVIGATION)
SYSTEMS INCLUDING)
REFERENCE AND)
LOCALIZATION FRAMES)

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

**RESPONSE TO NOTICE TO FILE CORRECTED
APPLICATION PAPERS AND PETITION TO CONTEND
ALLEGED OMISSION OF A DRAWING FIGURE**

In response to the communication of June 25, 2001, Applicants submit an Abstract for filing in the above referenced application and a copy of the Notice to File Corrected Application Papers.

Furthermore, Applicants hereby petition to contend that Figure 13E, as described in the specification, was in fact submitted along with the application papers filed in the U.S. Patent and Trademark Office on April 12, 2001. Fig 13E, shown on the lower half of Drawing Sheet No. 18, appears on the same sheet as Fig. 13D. The label delineating Fig. 13E was inadvertently left off the drawing originally submitted with the application papers. A copy of Drawing Sheet No. 18, with a correction indicated in red,

is enclosed herein. Also enclosed is a copy of the date-stamped postcard receipt. Applicants note the postcard receipt does not explicitly list Fig. 13E since the label for Fig. 13E was missing; however, the postcard receipt does provide evidence that Drawing Sheet No. 18, which contains Fig. 13E, was in fact included with the originally submitted application papers.

According to the fee schedule set forth in 37 C.F.R. § 1.17(i), the required fee payment of \$130.00 for consideration of this petition is enclosed herewith.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 24, 2001

By: 

Anthony M. Gutowski
Reg. No. 38,742

104240-8482860

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT,
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1300 I STREET, N. W.
WASHINGTON, DC 20005
202-408-4000



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Assistant Commissioner
for Patents
Washington, DC 20231

OFFICE OF INITIAL PATENT EXAMINATION

Sir:

REQUEST FOR CORRECTED FILING RECEIPT

We are forwarding herewith a copy of a Filing Receipt for the above-identified patent application. As indicated in ink on the attached copy, there is an error in the Filing Receipt. The error is the omission of a portion of the Domestic Priority Data. The missing data should read: --and Serial No. 08/319,615, filed October 7, 1994, now abandoned, which is a Continuation-In-Part of 08/053,076, filed April 26, 1993, now abandoned.--

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202-408-4000

170585-1

It is respectfully requested that a corrected Filing Receipt be issued as soon as possible.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 24, 2001

By: 

Anthony M. Gutowski
Reg. No. 38,742

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170585-1



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO.	DRAWINGS	TOT CLAIMS	IND CLAIMS
09/832,848	04/12/2001	3737	870	6148.0026-03	19	8	5

CONFIRMATION NO. 2372

22852

FINNEGAN, HENDERSON, FARABOW, GARRETT &
DUNN LLP
1300 I STREET, NW
WASHINGTON, DC 20005

FILING RECEIPT



OC000000006123641

Date Mailed: 05/29/2001

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Customer Service Center. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

Applicant(s)

Richard D. Bucholz, St. Louis, MO;
Kevin T. Foley, Memphis, TN;
Kurt R. Smith, Boulder, CO;
Daniel Bass, Moss Beach, CA;
Thomas Wiedenmaier, San Carlos, CA;
Todd Pope, San Francisco, CA;
Udo Wiedenmaier, San Mateo, CA;

RECEIVED

JUL 10 2001

FINNEGAN, HENDERSON,
FARABOW, GARRETT & DUNN, LLP

Domestic Priority data as claimed by applicant

THIS APPLICATION IS A DIV OF 09/105,068 06/26/1998
WHICH IS A DIV OF 08/809,404 07/23/1997 PAT 6,236,875
WHICH IS A 371 OF PCT/US95/12894 10/05/1995
WHICH CLAIMS BENEFIT OF 60/003,415 09/08/1995
(*) Data inconsistent with PTO records.

AND 08/319,615 10/7/1994

Foreign Applications

WHICH IS A CIP OF 08/053,076 04/26/93



648.0026-03

JKA/AMG/JAV

PLEASE STAMP TO ACKNOWLEDGE RECEIPT OF THE FOLLOWING:

BOX PATENT APPLICATION

NEW Divisional Application of: Richard D. BUCHOLZ et al.

Serial No: Unassigned Group Art Unit: 3737

(Divisional of 09/105,068)

Filed: Herewith Examiner: E. Mantis Mercader

For: SURGICAL NAVIGATION SYSTEMS INCLUDING
REFERENCE AND LOCALIZATION FRAMES

DOCUMENTS FILED:

1. New Divisional Application Transmittal Sheet (4 pages)
2. Complete Copy of Prior Application (57 Pages), including 55 Claims (5 Indep.), 19 Sheets of Drawings (Figs. 1, 2A, 2B, 3-10, 11, 11A-C, 12A-B, D, G, E, F, 13J, 13A-D, 13F-I), and Declaration (9 Pages);
3. Preliminary Amendment; and
4. Deposit account 06-0916 debit for \$870.00 (\$710 filing fee, \$160.00 for add'l claims).

Dated: April 12, 2001

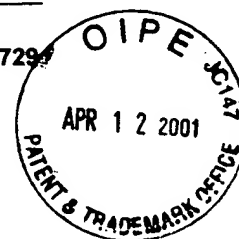
Atty Dkt No.: 06148.0026-03

Due Date: April 12, 2001

AMG/JAV

~~PLEASE~~ RETURN POSTCARD TO Kay Danna-MD#7299

APR 12 2001



Dkt 4601 73



UNITED STATES PATENT AND TRADEMARK OFFICE

 COMMISSIONER FOR PATENTS
 UNITED STATES PATENT AND TRADEMARK OFFICE
 WASHINGTON, D.C. 20231
 www.uspto.gov

APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
09/832,848	04/12/2001	Richard D. Bucholz	6148.0026-03

CONFIRMATION NO. 2372

FORMALITIES LETTER



OC00000006123642

 22852
 FINNEGAN, HENDERSON, FARABOW, GARRETT &
 DUNNER LLP
 1300 I STREET, NW
 WASHINGTON, DC 20005

07/26/2001 BAB:AMH1 00000025 09832848

01 FC:139

130.00 DP

Date Mailed: 05/29/2001

NOTICE TO FILE CORRECTED APPLICATION PAPERS

Filing Date Granted

This application has been accorded an Application Number and Filing Date. The application, however, is informal since it does not comply with the regulations for the reason(s) indicated below. Applicant is given **TWO MONTHS** from the date of this Notice within which to correct the informalities indicated below. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a)

The required item(s) identified below must be timely submitted to avoid abandonment:

- An abstract was not provided for this application. An abstract of the technical disclosure is required under 37 CFR 1.72(b).

The following item(s) appear to have been **omitted** from the application:

- Figure(s) **13E** described in the specification.

I. Should applicant contend that the above-noted omitted item(s) was in fact deposited in the U.S. Patent and Trademark Office (USPTO) with the nonprovisional application papers, a copy of this Notice and a petition (and \$130.00 petition fee (37 CFR 1.17(h))) with evidence of such deposit **must** be filed within **TWO MONTHS** of the date of this Notice. The petition fee will be refunded if it is determined that the item(s) was received by the USPTO.

II. Should applicant desire to supply the omitted item(s) and accept the date that such omitted item(s) was filed in the USPTO as the filing date of the above-identified application, a copy of this Notice, the omitted item(s) (with a supplemental oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such items), and a petition under 37 CFR 1.182 (with the \$130.00 petition fee (37 CFR 1.17(h))) requesting the later filing date **must** be filed within **TWO MONTHS** of the date of this Notice.

III. The failure to file a petition (and petition fee) under the above options (I) or (II) within **TWO MONTHS** of the date of this Notice (37 CFR 1.181(f)) will be treated as a constructive acceptance by the applicant of the application as deposited in the USPTO. **THIS TWO MONTH PERIOD IS NOT EXTENDABLE UNDER 37 CFR 1.136(a) or (b).** In the absence of a timely filed petition in reply to this Notice, the application will maintain a filing date as of the date of deposit of the application papers in the USPTO, and original

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application papers (i.e., the original disclosure of the invention) will include only those application papers present in the USPTO on the date of deposit.

In the event that applicant elects not to take action pursuant to options (I) or (II) above (thereby constructively electing option (III)), amendment of the specification to renumber the pages consecutively and cancel incomplete sentences caused by any omitted page(s), and/or amendment of the specification to cancel all references to any omitted drawing(s), relabel the drawing figures to be numbered consecutively (if necessary), and correct the references in the specification to the drawing figures to correspond with any relabelled drawing figures, is required. Any drawing changes should be accompanied by a copy of the drawing figures showing the proposed changes in red ink. Such amendment and/or correction to the drawing figures, if necessary, should be by way of preliminary amendment submitted prior to the first Office action to avoid delays in the prosecution of the application.

*A copy of this notice **MUST** be returned with the reply.*



Customer Service Center

Initial Patent Examination Division (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE

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